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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,918	08/13/2001	John Paulson	PAULJO-4	8046

39231 7590 04/05/2004

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MADISON, WI 53711

EXAMINER

MITCHELL, KATHERINE W

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

09/928,918

Applicant(s)

PAULSON, JOHN

Examiner

Katherine W Mitchell

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-17, 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |



### **DETAILED ACTION**

Claims 1-7 and 9-19 are pending. Claims 9-17 and 19 are withdrawn from consideration.

#### ***Election/Restrictions***

1. Claims 9-15 were newly submitted with the last amendment and restricted by original presentation in the last office action. They are still withdrawn from consideration as being directed to a non-elected invention.
2. Newly submitted claims 16-17 and 19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 9-15 and 19 are to a retaining wall system including stacked blocks, geosynthetic material, and a resilient pad. Claims 16-17 are directed to a method of constructing a segmental block retaining wall. The originally filed claims were to a pad capable of being disposed between blocks and transferring a load, but which could be used for other purposes including a gasket or membrane between any two hard surfaces. The claims did not positively require both a pad and a geosynthetic soil reinforcing material, and did not require a plurality of stacked blocks.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-15 and 16-17 and 19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***



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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by PGI Technical Bulletin of December, 1999, hereafter called PGI-1999.

Re claims 1 and 3 and 5: PGI-1999 teaches a pad comprising resilient material **capable of** being disposed between block layers in a wall, capable of transferring tensile load from a geosynthetic soil reinforcing material to the wall block face in the last paragraph of page 1 and 1<sup>st</sup> two paragraphs of page 2. PGI-1999 further teaches that PVC Geomembranes are used with "nonwoven geotextile, ...geonet ... interfaces (Summary paragraph, page2) because of its inherent ability to resist tearing and pulling and its shear resistance along component interfaces, including interfaces with another gosynthetic component (1<sup>st</sup> paragraph page 1, Table 1, page 3). Although specific percentages are not given, the only limitation provided by applicant to obtain the claimed 14% or greater increase in tensile load transfer is that the pad be resilient material such as PVC. No other specific treatment of the pad or unique composition is disclosed; (Specification page 5, line 2 – any shape will provide benefits; line 4 – pad thickness is determined based on block irregularities and line 11 – other thicknesses may be used) thus inherently to meet the enablement requirement, any PVC pad must inherently meet the limitation.



Re claim 6: The pad is inherently **capable of** being inserted between courses of segmental block wall, and capable of fitting the block shape and providing frictional connection between a soil reinforcing geosynthetic and a wall.

Re claim 7: PVS pads are inherently compressible, and can be made to the thickness required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over PGI-1999 in view of Blanc US Patent 2687034.

Re claim 2; PGI-1999, as discussed above, teaches a resilient pad capable of placement between horizontal layers of blocks. However, PGI-1999 does not specify that the pad should be shaped to approximately match the horizontal surface of the blocks. Blanc teaches a resilient pad between horizontal layers of blocks shaped to approximately match the horizontal surface of the blocks in Figs 1 and 2. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PGI-1999 to include a resilient pad shaped to approximately match the horizontal surface of the blocks as taught by Blanc in order to ensure that the contact surfaces are covered without wasting material.



Re claim 4 ; PGI-1999, as discussed above, teaches a resilient pad capable of placement between horizontal layers of blocks. However, PGI-1999 does not specify that the pad should have a thickness sufficient to substantially fill voids and uneven surfaces between adjacent horizontal surfaces of retaining blocks. Blanc teaches in col 3 lines 27-33 and Fig 2 that a *gasket* 22 can be used between adjacent horizontal surfaces of retaining blocks. Gaskets by definition serve to seal by providing a thickness suitable to substantially fill voids and uneven surfaces, and using a pad as a gasket as is well-known for its properties of cushioning and sealing between generally flat parallel surfaces. A search on "gasket definition" on [www.google.com](http://www.google.com) returned:

A preformed shape of rubber or rubber-like composition used to fill and seal joints or openings either along or in conjunction with a supplemental application of a sealant.  
[www.ppg.com/gls\\_ppglass/architect/glossary.htm](http://www.ppg.com/gls_ppglass/architect/glossary.htm)

A thin layer of material placed between two surfaces or joints to make a tight seal. Cylinder head and exhaust manifold gaskets are now made from a variety of high-tech materials, including composites and multi-layered steel.  
[www.dana.com/investors/99annual/glossary.htm](http://www.dana.com/investors/99annual/glossary.htm)

A strip, sheet or ring of rubber or other type of sealing material, that when used under pressure, will prohibit the entry of water, dust, etc.  
[www.trimarkhardware.com/goweb/corporate/glossary.jsp](http://www.trimarkhardware.com/goweb/corporate/glossary.jsp)

A material usually made of rubber, cork, metal, paper or a combination thereof that is placed between two surfaces to ensure proper sealing against the passage of air, liquid or vapors. Valve cover gaskets are one example of a popular gasket.  
[www.mrpttomcruiser.com/glossaryofautoterms.html](http://www.mrpttomcruiser.com/glossaryofautoterms.html)

Thus the term "gasket" in Blanc inherently includes the claimed properties.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified PGI-1999 to include a resilient pad with a thickness sufficient to substantially fill voids and uneven surfaces between adjacent



horizontal surfaces of retaining blocks as taught by Blanc in order to ensure that the pad serves as a gasket to ensure a good "grip".

Re claim 18: Blanc teaches in col 3 lines 27-33 and Fig 2 a gasket "adhesively connected" to the block. It has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

### ***Response to Arguments***

7. Applicant's arguments filed 6-19-2003 have been fully considered but they are moot in view of the new grounds of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

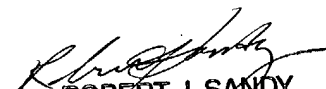
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwm  
4/1/2004

  
ROBERT J. SANDY  
PRIMARY EXAMINER